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10/058,126	01/29/2002	Boris Gefwert	3502-1002	3487

466 7590 07/12/2007  
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EXAMINER
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TINKLER, MURIEL S

ART UNIT	PAPER NUMBER
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3691

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07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/058,126	<b>Applicant(s)</b> GEFWERT ET AL.	
	<b>Examiner</b> Muriel Tinkler	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on 25 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 20-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____  |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :2/19/2004,  
4/22/2002, 1/29/2002.

### **DETAILED ACTION**

This application has been reviewed. Claims 1-19 have been cancelled. Claims 20-33 have been added and are pending. The response to arguments and election/restriction(s) are as follows.

#### ***Response to Amendment***

1. Claims 1-19 have been cancelled.
2. Claims 20-33 have been added, reviewed against the specification and accepted for review.

#### ***Response to Arguments***

3. If the arguments filed April 25, 2007 are applicable toward Claims 1-19:  
Applicant's arguments with respect to claims 1-19 have been considered but are moot. Claims 1-19 have been withdrawn therefore the rejection(s) of Claims 1-19 have been withdrawn.

- a. Applicant's arguments filed April 25, 2007 have been fully considered but they are not persuasive. The Applicant argues that Falk teaches an electronic signature but does not teach the use of an open network on pages 6-7.  
However, Schmitz does teach the use of an open network (Internet) in column 5 (lines 3-6).

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- b. The Applicant also argues that Falk, "does not mean or even hint at the digital signing of a form as in the present invention." The Examiner disagrees. Falk does teach the digital signing of a form, according to the claims as written in the correspondence sent on April 25, 2002. Specifically, Falk discloses in column 2 (lines 6-13), "The personal unit includes a receiver for receiving a transmitted challenge code and an algorithm unit which processes the challenge code, a user input such as a personal identification number (PIN) or **electronically recognizable signature**, and an internally stored security key for calculating a response code according to a pre-stored algorithm."
4. The Examiner will assume that the Applicant argues the validity of the rejection(s) with respect to the Claims, as written, in the correspondence filed on April 25, 2007.
5. The reply filed on April 25, 2007 is not fully responsive to the prior Office Action because: The Applicant does not address the rejection(s) with respect to the Office Action mailed on January 25, 2007. Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a).
6. The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of

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extension and the corresponding amount of the fee. In no case may an applicant reply outside the SIX (6) MONTH statutory period or obtain an extension for more than FIVE (5) MONTHS beyond the date for reply set forth in an Office action. A fully responsive reply must be timely filed to avoid abandonment of this application.

***Election/Restrictions***

7. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-19 drawn to a method for accepting transferred data related to a transaction on an open network.

Group II. Claims 20-33, drawn to a method and arrangement for digitally signing a form on an open and closed network.

8. Claims 1-19 generic to the following disclosed patentably distinct species: accepting transferred data. The species are independent or distinct because the acceptance of transferred data is not a necessary or required part of Group II. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

The inventions are distinct, each from the other because of the following reasons:

10. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

11. The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

12. Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions

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unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

13. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

14. Claims 1-19 have been cancelled. Therefore by default, the Applicant has elected Claims 20-33 for review.

***Claim Rejections - 35 USC § 112***

15. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

16. Claims 21, 22, 24, 25 and 29-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

17. Claim 21 recites the limitation "the parties" and "the transfer of data" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. Claim 21 is dependent on Claim 20. There is no language that refers to "a party", "parties" or



"transfer of data" in Claim 20. Therefore, it is unclear what the Applicant is referring to when stating "the parties" and "the transfer of data".

18. Claim 22 recites the limitation "the parties" and "the transfer of data" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. Claim 22 is dependent on Claim 20. There is no language that refers to "a party", "parties" or "transfer of data" in Claim 20. Therefore, it is unclear what the Applicant is referring to when stating "the parties" and "the transfer of data".

19. Claim 24 recites the limitation "the decryption of data" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. There is no language that refers to "decryption of data" in Claim 20. Therefore, it is unclear what the Applicant is referring to when stating "the decryption of data".

20. Claim 25 recites the limitation "the data" and "said transaction" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. There is no language that refers to "data" or "a transaction" in Claim 20. Therefore, it is unclear what the Applicant is referring to when stating "the data" and "said transaction".

21. Claim 29 recites the limitation "The arrangement according to claim 20" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 20 does not discuss or use the term "arrangement". Therefore, it is unclear what the Applicant is

referring to when stating "The arrangement". The Examiner will assume that the Applicant is referring to claim 26 not claim 20.

22. Claim 30 recites the limitation "The arrangement according to claim 20" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 20 does not discuss or use the term "arrangement". Therefore, it is unclear what the Applicant is referring to when stating "The arrangement". The Examiner will assume that the Applicant is referring to claim 26 not claim 20.

23. Claims 31 and 33 recites the limitation "The arrangement according to claim 30" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 30 is rejected under 35 USC 112, 2<sup>nd</sup> paragraph for lack of antecedent basis. Because Claims 31 and 33 are dependent on claim 30, they are also rejected under 35 USC 112, 2<sup>nd</sup> paragraph.

24. Claim 32 recites the limitation "The arrangement according to claim 31" in line 1. There is insufficient antecedent basis for this limitation in the claim. Claim 31 is rejected under 35 USC 112, 2<sup>nd</sup> paragraph for depending on claim 30, which was also rejected for lack of antecedent basis. Because Claim 32 is dependent on claim 31, it is also rejected under 35 USC 112, 2<sup>nd</sup> paragraph.

***Claim Rejections - 35 USC § 102***

25. Claims 1-3, 5 and 7-19 have been cancelled therefore the 35 USC 102 rejection(s) of these claims has been withdrawn.

***Claim Rejections - 35 USC § 103***

26. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

28. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

29. Claims 4 and 6 have been cancelled therefore the 35 USC 103 rejection(s) of these claims has been withdrawn.

30. Claims 20-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmitz (US 6,078,908 A) in view of Falk et al. (US 5,668,876 A), hereafter Schmitz and Falk respectively.

31. Claims 20, 26, 27 and 29 discuss a method and arrangement for digitally signing a form of a user of a server in an information network comprising both an open (Internet) and a closed network, the method comprising: - sending from a user's terminal of the open network a signature request concerning the form to be digitally signed to a closed-network service provider via an open-network service provider, and further to a user's terminal of the closed network, - accepting said signature request by entering a code at the user's terminal of the closed network, - transferring said accepted signature request to the open-network service provider via the closed-network service provider, and further to the user's terminal of the open network in order to connect said accepted signature request to said form to be digitally signed, and - wherein the service provider of the closed network offers verification service to the receiver of the digitally signed form in order to verify the authenticity of the digitally signed form. Schmitz discloses:

a. Using an open network (Internet) and a closed network (LAN) on page 5 and lines 3-6, "The present invention can be universally employed in the region of data transmission systems. This holds for example also for the Internet and intranets, local area networks LAN, wide area networks WAN, etc."

b. Verifying authenticity on page 1 and lines 45-62, "The present invention provides for a method for the authorization of data transmission systems. A qualifying identification of a user is entered into a data input apparatus. The qualifying identification and a request for an authorization signal is transmitted from the data input apparatus to an authorization computer along a first transmission path. The authorization signal is established in the authorization computer. The authorization signal is sent from the authorization computer to a monitor along a second transmission path different as compared to the first transmission path. The authorization signal at the monitor is read by the user. The authorization signal is entered into the data input apparatus. The authorization signal is transmitted from the data input apparatus to the authorization computer. The validity of the authorization signal is verified in the authorization computer. A connection is established between the data input apparatus and a receiver unit upon verification of the validity of the authorization signal."

32. Schmitz does not disclose the use of an electronic signature. Falk et. al. teaches on page 2 and lines 6-11, "The personal unit includes a receiver for receiving a transmitted challenge code and an algorithm unit which processes the challenge code,

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a user input such as a personal identification number (PIN) or electronically recognizable signature, and an internally stored security key for calculating a response code according to a pre-stored algorithm." Therefore it would have been obvious to a person known in the art at the time the invention was made to modify Schmitz in view of Falk et. al. to allow the user to digitally sign the form for ease of use and efficiency purposes.

33. Claim 21 discusses the method according to claim 20, wherein the parties associated with the transfer of data are identified by a service provider. Claim 20 was rejected based on the discussion(s) above. Schmitz discloses on page 1 and lines 45-50 and page 1 and lines 58-62, "The present invention provides for a method for the authorization of data transmission systems. A qualifying identification of a user is entered into a data input apparatus. The qualifying identification and a request for an authorization signal is transmitted from the data input apparatus to an authorization computer along a first transmission path... The validity of the authorization signal is verified in the authorization computer. A connection is established between the data input apparatus and a receiver unit upon verification of the validity of the authorization signal."

34. Claim 22 discusses the method according to claim 20, wherein the parties associated with the transfer of data are identified by a reliable third party. Claim 20 was rejected based on the discussion(s) above. Schmitz does not discuss that a reliable

third party identifies parties associated with the transfer of data. Falk et. al. teaches on page 1 and lines 6-9, "The present invention involves a method and an apparatus for authentication of a user attempting to access an electronic service, and, in particular, providing an authentication unit which is separate from preexisting systems." Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Schmitz by using Falk to use a third party to identify the parties associated with the transfer of data for added security.

35. Claim 24 discusses the method according to claim 20, wherein the decryption of data related to said transaction is performed using a service user's terminal. Claim 20 was rejected based on the discussion(s) above. Schmitz discloses on page 4 and lines 47-48, "It is clear that the transmission to such receiver apparatuses can also be encoded and/or encrypted." While Schmitz does not specifically state that the receiver has a decryption module, it would be obvious to a person known in the art at the time the invention was made to include a decryption technique on the receiver so that the user can view the data.

36. Claims 28 and 30 discusses the arrangement according to claims 26 and 20, wherein said closed network is a mobile telephone network or wireless terminal. Claims 20 and 26 were rejected based on the discussion(s) above. Schmitz discloses on page 2 and lines 44-48, "Wireless telecommunication apparatuses, such as for example mobile or cellular phone (Handie-Talkie is a tradename of the Motorola Communications

Division) or pagers, are frequently furnished with the possibility to receive short alphanumeric communications.”

37. Claims 23, 31 and 32 discuss the method and arrangement according to claims 20 and 30, wherein said code entered at a terminal is a PIN code that can be authenticated by a SIM card, the terminal has a SIM card, and an encryption key is stored on a SIM card of the terminal. Claims 20 and 30 were rejected based on the discussion(s) above. Schmitz discloses on page 4 and lines 10-20, “A wireless receiver, for example in the form of a plug-in card, is incorporated as a receiver in the data input apparatus, representing the lowest security level according to the present invention, such that a data transmission is possible to the receiver unit only with this concrete apparatus. In order to increase this security, it can be provided that this wireless receiver can only be operated with a user identification element, for example a magnetic card or a chip card. The user identification element can also operate with graphical methods, such as testing, verification and/or identification of a fingerprint or of a picture identification of the user.”

38. Claims 25 and 33 discusses the method and apparatus according to claims 20 and 30, wherein the data related to the acceptance of said transaction are encrypted using a service user's terminal. Claims 20 and 30 were rejected based on the discussion(s) above. Schmitz discloses on page 3 and lines 43-55, “The transaction authorization number or the comparable password can be a transaction authorization



number for one single use. However, other limitations such as the user time and/or the number or the size of the data files to be transmitted relating are also conceivable for use in determining the validity of the transaction authorization number or of the comparable password. Now, data can be transmitted from the data input apparatus to the receiver unit and vice versa, for example by full duplex, after a connection authorized in the above described manner has been established. It is clear that these data can also be encrypted or encoded first and then transmitted for obtaining additional security."

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Muriel Tinkler whose telephone number is (571)272-7976. The examiner can normally be reached on Monday through Friday from 7:30 AM until 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MT  
June 25, 2007



HANI M. KAZIMI  
PRIMARY EXAMINER